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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,870	01/05/2004	Takeshi Satoh	57454-994	3233

7590 03/08/2006  
McDermott, Will & Emery  
600 13th Street, N.W  
Washington, DC 20005-3096

EXAMINER
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JOHNSON, EDWARD M

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/750,870

Applicant(s)

SATO ET AL.

Examiner

Edward M. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahata et al. US 6,284,690 in view of Kato et al. US 5,603,877.

Regarding claims 1 and 9, Nakahata '690 discloses a method of making porous  $\text{Si}_3\text{N}_4$  comprising mixing a sintering aid (abstract) comprising 0.5-17% of a rare earth element (see column 3, lines 39-42); adding binder; molding (column 2, lines 32-35); heating at 200-800 degrees C (see column 1, lines 64-66) removing the binder (see column 4, lines 38-41); then nitriding and sintering by raising the temperature from 800 to 1800 in the nitrogen atmosphere (see column 5, lines 30-33).

Nakahata fails to disclose a pressure of 0.1-1 atmosphere.

Kato '877 discloses a sintering pressure of at least 0.1 or 5-20 atmG.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pressure of at least 0.1 or 5-20 atmG of Kato in the silicon nitride sintering process of Nakahata because Kato discloses the sintering pressure in a sintering process for making silicon nitride (see title, abstract) to obtain "a denser ceramic structure" (see column 4, lines 50-52), and also because Nakahata '690 discloses heating in a "nitrogen atmosphere" (see Example 1), which would obviously, to one of ordinary skill, at least motivate an ambient pressure of about one atmosphere at least including 0.5 atm.

Regarding claim 2, Nakahata '690 discloses composite compounds containing "at least one of" rare earth and Group II compounds (see column 3, lines 25-35).

Regarding claims 3-4, Kato '877 discloses a sintering pressure of at least 0.1 or 5-20 atmG.

#### ***Response to Arguments***

3. Applicant's arguments filed 2/21/06 have been fully considered but they are not persuasive.

It is argued that Applicants have amended claims 1 and 9... 0.1-0.5 atmosphere. This is not persuasive because Kato '877 discloses a sintering pressure of at least 0.1 or 5-20 atmG.

It is argued that furthermore, Kato describes the advantage... (Kato, column 4, lines 48-52). This is not persuasive because Applicant cites various limitations in the specification. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). It is also noted that the features upon which applicant relies (i.e., aggressively decompose, re-precipitate, thinner columnar crystals, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is argued that in the present invention, the sintering step... of the specification. This is not persuasive for the reasons above.

It is argued that as described above, there is no motivation... the present invention. This is not persuasive for the reasons above and because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pressure of at least 0.1 or 5-20 atmG of Kato in the silicon nitride sintering process of Nakahata because Kato discloses the sintering pressure in a sintering process for making silicon nitride (see title, abstract) to obtain "a denser ceramic structure" (see column 4, lines 50-52), and also because Nakahata '690 discloses heating in a "nitrogen atmosphere" (see Example 1), which would obviously, to one of ordinary skill, at least motivate an ambient pressure of about one atmosphere at least including 0.5 atm.

#### **Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman

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can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Edward M. Johnson  
Primary Examiner  
Art Unit 1754

EMJ